

## REMARKS

After entry of this Amendment, the pending claims are: claims 1-13, 15, 16, 20-32, 34-51 and 55-76. The Office Action dated June 22, 2007 has been carefully considered. Claims 14, 18 and 19 have been canceled without prejudice. Claims 17, 33, and 52-54 were previously canceled. Claims 1, 11, 12, 16, and 20 have been amended without prejudice. No new matter has been added. The Examiner is thanked for allowance of claims 51 and 55-76. The Examiner is further thanked for the indication of allowable subject matter in claims 14, 19, 20, 38, 43, and 44. As an initial matter independent claim 1 has been amended to include some of the limitations of claim 14 and independent claim 16 has been amended to include all of the limitations of claim 19 and intervening claim 18. Reconsideration and allowance of the present application in view of the above Amendments and the following Remarks is respectfully requested.

In the Office Action dated June 22, 2007, the Examiner:

- rejected claims 1-12, 15, 16, 21-23, 27-32, 34-36 and 45-47 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,660,006 to Markworth *et al.* (“Markworth”);
- rejected claims 1, 11, 16, 18, 27, 35-37, and 40-42 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,440,133 to Beale *et al.* (“Beale”);
- rejected claims 24-26 and 48-50 under 35 U.S.C. 103(a) as being unpatentable over Markworth in view of U.S. Patent No. 5,688,274 to Errico *et al.* (“Errico”);
- rejected claims 12 and 13 under 35 U.S.C. 103(a) as being unpatentable over Beale;
- objected to claims 14, 19, 20, 38, 43, and 44 as being dependent on a rejected base claim. Otherwise the subject matter of claims 14, 19, 20, 38, 43, and 44 would be allowable; and

- allowed claims 51 and 55-76.

## **INDEPENDENT CLAIM 1**

Independent claim 1 has been rejected as being anticipated by Markworth. Moreover, independent claim 1 has also been rejected as being anticipated by Beale. As an initial matter, the Examiner is thanked for the indication of allowable subject matter in dependent claim 14. Independent claim 1 has been amended to include some of the limitations of dependent claim 14. Independent claim 1 has not been amended to include the limitations of the intervening claims as it is not believed that these addition limitations are necessary in order to distinguish independent claim 1 from the cited prior art.

As amended, independent claim 1 requires, *inter alia*, a surgical instrument comprising a holder assembly for engaging the spinal implant, a release assembly for contacting the longitudinal spinal member, and an actuating member operatively associated with the holder assembly and the release assembly so that actuation of the actuating member moves the holder assembly with respect to the release assembly; wherein the actuating member includes a first tip and a second tip, the first and second tips being sized and configured to slide onto and engage the holder and release assemblies, respectively.

Markworth discloses a body 200, a slide 300, a sleeve 400 and a trigger 500 wherein the trigger 500 connects the slide 300 to the body 200. The trigger 500 includes a plurality of lower holes 508 which are generally aligned with threaded holes 220 formed in the body 200 and a plurality of upper

holes 506 which are generally aligned with threaded holes 306 formed in the slide 300. Screws 106 secure the trigger 500 to the body 200 while screws 108 secure the trigger 500 to the slide 300.

It is respectfully submitted that Markworth does not disclose, teach, or suggest an actuating member that includes a first tip and a second tip wherein the first and second tips are sized and configured to slide onto and engage the holder and release assemblies, respectively. Rather, Markworth discloses a trigger that threadably engages a body and a slide, thus it is respectfully submitted that Markworth does not disclose, teach or suggest all of the limitations of independent claim 1. Withdrawal of this rejection and allowance of independent claim 1 is respectfully requested.

Moreover, independent claim 1 has been rejected as being anticipated by Beale. It is respectfully submitted that Beale does not disclose, teach, or suggest an actuating member that includes a first tip and a second tip wherein the first and second tips are sized and configured to slide onto and engage the holder and release assemblies, respectively. Rather, Beale discloses a fastener engaging member 80 and a reducing member 100 coupled together by an actuator assembly 51 wherein the actuator assembly 51 is pivotally coupled to the fastener engaging member 80 via a pin 99 and is pivotally coupled to the reducing member 100 via pivot pins 118. Thus it is respectfully submitted that Beale does not disclose, teach or suggest all of the limitations of independent claim 1. Withdrawal of this rejection and allowance of independent claim 1 is respectfully requested.

For at least the above-identified reasons, it is respectfully submitted that neither Markworth or Beale disclose, teach or suggest all of the limitations of independent claim 1. Thus, it is respectfully

submitted that independent claim 1 is allowable over the cited prior art. Withdrawal of these rejections and allowance of independent claim 1 is respectfully requested.

Furthermore, as claims 2-13, 15, and 21-26 all depend from independent claim 1, it is submitted that these claims are equally allowable. Withdrawal of these rejections and allowance of claims 2-13, 15, and 21-26 is also respectfully requested.

#### **INDEPENDENT CLAIM 16**

Independent claim 16 was rejected as being anticipated by Markworth. Moreover, independent claim 16 has also been rejected as being anticipated by Beale. As an initial matter, the Examiner is thanked for the indication of allowable subject matter in claim 19. Claim 19 was objected to as being dependent on a rejected base claim. Otherwise the subject matter of claim 19 was indicated as being allowable if it was rewritten in independent claim form to include all of the limitation of the base claim and any intervening claims. Independent claim 16 has been amended to include all of the limitations of independent claim 19, including all of the limitations of intervening claim 18.

Thus, it is respectfully submitted that neither Markworth or Beale disclose, teach or suggest all of the limitations of independent claim 16. Thus, it is respectfully submitted that independent claim 16 is allowable over the cited prior art. Withdrawal of this rejection and allowance of independent claim 16 is respectfully requested.

Furthermore, as claim 20 depends from independent claim 16, it is submitted that claim 20 is equally allowable. Withdrawal of this rejection and allowance of claim 20 is also respectfully requested.

## **INDEPENDENT CLAIMS 27 AND 40**

Independent claims 27 and 40 were rejected as being anticipated by Markworth. Moreover, independent claims 27 and 40 were rejected as being anticipated by Beale.

Independent claims 27 and 40 both require, *inter alia*, a surgical instrument for urging a longitudinal spinal member into a top-loading spinal implant, the instrument comprising a holder assembly having a distal end, the distal end including an elongated slot; a release assembly having a tubular member and a pusher member, the tubular member being sized and configured to be slidably disposed within the holder assembly, and the pusher member being sized and configured to slidably surround at least a portion of the holder assembly; wherein the tubular member and the pusher member each include a distal end, the distal end of the tubular member includes at least one hole and the pusher member includes at least one aperture, the at least one hole and the at least one aperture being sized and configured to receive **at least one pin for securing the pusher member to the tubular member, the pin being sized and configured to be displaceable within the elongated slot of holding assembly.**

It is respectfully submitted that there is absolutely no disclosure in either Markworth or Beale of a holder assembly having an elongated slot formed at the distal end thereof and a release assembly including a tubular member and a pusher member, wherein the distal end of the tubular member includes at least one hole and the pusher member includes at least one aperture for receiving a pin for securing the pusher member to the tubular member, the pin being sized and configured to be displaceable within the elongated slot formed in the distal end of the holding assembly.

Rather, as stated by the Examiner, Markworth discloses a holder assembly (*i.e.*, the body 200) and a release assembly wherein the release assembly includes a tubular member (*i.e.*, the slide 300) and a pusher member (*i.e.*, the sleeve 400). The distal end of the holder assembly (*i.e.*, the body 200) including an elongated slot. The distal end of the tubular member (*i.e.*, the slide 300) includes at least one hole 308 and the pusher member (*i.e.*, the sleeve 400) includes at least one aperture 412 for receiving a pin (*i.e.* a screw 112). “[t]he pusher (400) having a recess at the left most portion of 404 for engaging a longitudinal spinal rod (114); the fingers (206) define a U-shaped recess configured to correspond with the recess formed in the pusher member to allow the spinal rod to extend completely through the holder assembly and pusher assembly.

It is respectfully submitted that as written, independent claims 27 and 40 require the tubular member to be slidably disposed within the holder assembly while the pusher member is slidably disposed about the holder assembly. **The tubular member being connected to the pusher member via a pin. The pin being located in an elongated slot formed in the holding assembly. Thus, as written, independent claims 27 and 40 require the pin, which interconnects the pusher member with the tubular member to be located in the slot formed in the holder assembly.**

The Applicants believe that the Examiner is incorrectly interpreting the pin to be the longitudinal spinal rod, it is respectfully submitted that as written, independent claims 27 and 40 require (i) the pin to connect the pusher member with the tubular member and (ii) the pin to pass through a slot formed in the holder assembly. As such, the pin can not be interpreted to be the longitudinal spinal rod.

Similarly, Beale discloses a reducing member 100 that is slidably disposed about a fastener engaging member 80. Beale further discloses an extension member 500 that can be positioned about the reducing member 100 to allow for additional reduction. There is absolutely no disclosure, teaching or suggestion in Beale of providing a tubular member slidably disposed within a holder assembly and a pusher member slidably disposed about the holder assembly. **The tubular member being connected to the pusher member via a pin. The pin being located in an elongated slot formed in the holding assembly. There is absolutely no disclosure, teaching or suggestion of providing a pin for connecting the pusher member to the tubular member, the pin being located in a slot formed in the holder assembly.**

Therefore, it is respectfully submitted that as, as amended, independent claims 27 and 40 are allowable over the cited prior art. Withdrawal of these rejections and allowance of independent claims 27 and 40 is respectfully requested.

Furthermore, as claims 28-32, 34-39, and 45-50 all depend from independent claim 27 and, as claims 41-44 all dependent from independent claim 40, it is submitted that these claims are equally allowable. Withdrawal of these rejections and allowance of claims 28-32, 34-39, and 41-50 is also respectfully requested.

## CONCLUSION

No fee is believed due for this submission. If, however, the Commissioner determines otherwise, the Commissioner is authorized to charge any fees which may now or hereafter be due in this application to Deposit Account No. 19-4709.

In the event that there are any questions, or should additional information be required, please contact Applicants' attorney at the number listed below.

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Respectfully submitted,

/Giuseppe Molaro/

Giuseppe Molaro

Registration No. 52,039

For: Brian M. Rothery

Registration No. 35,340

Attorney for Applicants  
Stroock & Stroock & Lavan LLP  
180 Maiden Lane  
New York, New York 10038  
(212) 806-6114